

**Remarks**

The Examiner withdrew the primary reference U.S. Patent No. 6,682,638 to Prohaska (US Prohaska) because it is disqualified as prior art due to common ownership with the present application and instead cited a new primary reference, WO 01/36957 to Prohaska (WO Prohaska), which is international publication of US Prohaska. The Examiner rejected claims 20, 21, 23-28, 30, 31, 33, and 34 under 35 USC §103 as being obvious over in view of WO Prohaska in view of any of the following references: U.S. Patent No. 4,272,353 to Lawrence; U.S. Patent No. 6,319,293 to Debe; U.S. Patent No. 4,879,005 to Fray; or U.S. Patent No. 5,547,551 to Bahar. Based on the following remarks, Applicants submit all claims should be allowed.

All claims relate to an ionomer membrane that is dry during the steps of providing the at least one opening in the substrate, placing the electrode proximate to the at least one opening, contacting the dry ionomer membrane to the substrate and electrode, providing at least one hole in the ionomer membrane, and aligning the at least one hole with the at least one opening for defining a gas passage.

As stated in the outstanding Office Action, WO Prohaska is relied upon for teaching the use of an opening 6 that extends through both a portion of the substrate 10 and the ionomer membrane 5 thereby defining a passage (paragraph 3 of the Office Action). Also as stated in the Office Action, the Examiner is relying upon this teaching in WO Prohaska to show Applicants' limitation of a hole in the ionomer membrane that is aligned with at least one opening in the substrate (paragraph 3). With respect to claims 33 and 34, the Examiner relies upon WO Prohaska for teaching a reservoir 9 and for the reservoir to be obviated if the humidity in the atmosphere is sufficient.

In view of the enclosed affidavit filed under 37 CFR 1.131 and its attachment, the date of the invention of the present application is before the publication date of WO

Prohaska, and, therefore, WO Prohaska is not prior art to the present application. Applicants are having difficulty locating one of the two co-inventors and therefore are enclosing only one signed affidavit. Applicants will forward the second signed affidavit when it becomes available.

Because WO Prohaska is no longer prior art, and because none of the remaining references are relied upon by the Examiner for teaching or suggesting the step of providing a substrate, providing an opening in the substrate, placing an electrode proximate to the opening, contacting a membrane to the substrate and electrode, a hole in the membrane, and aligning the hole with the opening for defining a gas passage, the rejections under 35 USC §103 should be withdrawn.

Because the rest of the cited art are relied upon for showing a dry ionomer membrane, a combination of these references does not result in the steps of providing a substrate, providing an opening in the substrate, placing an electrode proximate to the opening, contacting a membrane to the substrate and electrode, a hole in the membrane, and aligning the hole with the opening for defining a gas passage. Hence, even assuming that the references show what the Examiner states in the Office Action, and Applicants are not conceding this to be true, the combined references would not arrive at Applicants' claimed invention absent WO Prohaska.

In order for the combined remaining references to arrive at Applicants' claimed invention, the combined references need to be modified. However, there must be some teaching or suggestion in the cited art in order to provide motivation for one skilled in the art to make the modification. Absent such teaching or suggestion, one skilled in the art would not have the motivation to make the suggested modification and, therefore, such modification in the absence of these requisite teachings or suggestions is improper. As discussed above, the none of these references teach or suggest, and therefore neither does the combination of references, placing the electrode proximate to the

at least one opening, contacting the dry ionomer membrane to the substrate and electrode, providing at least one hole in the ionomer membrane, and aligning the at least one hole with the at least one opening for defining a gas passage.

Without these requisite teachings or suggestions, there is no motivation to properly modify the cited art under 35 USC §103 and the rejections should be withdrawn. Based on the foregoing, WO Prohaska is no longer prior art to teach or suggest the steps of providing a substrate, providing an opening in the substrate, placing an electrode proximate to the opening, contacting a membrane to the substrate and electrode, a hole in the membrane, and aligning the hole with the opening for defining a gas passage and the remaining references are not relied upon for showing these limitations. Therefore, Applicants submit that all claims are in condition for allowance.

Respectfully submitted,

/ Wesley W. Whitmyer, Jr./

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Otto J. Prohaska, <i>et al.</i>
Application No. 10/029,659	Filing Date: October 22, 2001.
Title of Application:	Electrochemical Sensor With Dry Ionomer Membrane
Confirmation No. 4969	Art Unit: 1753
Examiner	

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**Declaration of Inventors of Prior Invention Under 37 CFR §1.131**

I, Avinash Dalmia, declare as follows:

1. I am an inventor named in the above application.
2. I, along with co-inventor Otto J. Prohaska, conceived of the invention described and claimed in the above application at least as early as March 2000, including the subject matter of all pending claims in U.S. Patent Application No. 10/029,659.
3. Attached hereto is a copy of our June 22, 2000 invention disclosure which specifies the date of conception as being March 2000.
4. I diligently worked on developing and perfecting our invention from March 2000 until the invention was reduced to practice.
5. I constructively reduced my invention to practice no later than October 22, 2001 upon the filing of patent application serial-number 09/515,724.
6. All statements in this Declaration made of my own knowledge are true and all statements made on information and beliefs are believed to be true.
7. I understand that willful false statements and the like are punishable by fine or imprisonment or both and may jeopardize the validity of the application or any patent issuing thereon.

I hereby declare, under penalty of perjury under the laws of the United States of America, that the foregoing statements are true and correct.

October 31, 2007

  
Avinash Dalmia